

REMARKS

The last OA states that it is responsive to the communication filed on 16 December 2003. The communication filed by applicant on December 16, 2003 submits the previously filed unentered Amendment-B filed September 2, 2003. Thus, the claim 21 presently on file is the claim 21 as it appears in the Amendment-B.

THE CLAIM REJECTION UNDER 35 U.S.C. SECTION 103.

The last OA alleges that claim 21 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Lang in view of Brodrib.

Applicant respectfully requests reconsideration of this rejection for the following reasons.

- (1) There is no justification in Lang and Brodrib, or any other prior art separate from applicant's disclosure, which suggests that these references be combined, much less be combined in the manner proposed in the last O.A.
- (2) The proposed combination would not be physically possible nor operative.
- (3) Even if Lang and Brodrib were to be combined in the manner proposed, the proposed combination would not show all of the novel physical features of applicant's claim.
- (4) The results achieved by applicant's invention are superior and unsuggested by the applied references.
- (5) Up to now, those skilled in the art thought or were skeptical that the techniques used in applicant's invention were unworkable or presented an insuperable barrier.
- (6) Up to now, those skilled in the art thought or found the problem solved by applicant's invention was insoluble, that is, the invention converts failure into success. The failures of prior art workers indicate that a solution was not obvious.

- (7) Applicant's invention is classified in a crowded art. Therefore, a small step forward should be considered significant.
- (8) The prior art lacks any suggestion that the references should be modified or combined in a manner required to meet the claim.
- (9) The references do not teach what the Examiner relies upon them supposedly teaching.
- (10) Applicant's invention solves a long-felt, long-existing, but unsolved need.
- (11) The Examiner has made a strained interpretation of the references that could be made only by hindsight.
- (12) Applicant's invention solves a different problem than the problem addressed by the two applied references.
- (13) The Examiner has not presented a convincing line of reasoning as to why the claimed subject matter as a whole, including its differences over the prior art, would have been obvious.
- (14) The prior art references do not contain any suggestion (expressed or implied) that they be combined, or that they be combined in the manner suggested.
- (15) Each reference is complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to any reference.
- (16) The applied references take mutually exclusive paths and reach different solutions to solve different problems. Since they teach away from each other, it would not be logical to combine them.
- (17) The references themselves teach away from the suggested combination.
- (18) The references are from different technical fields than that of applicant's invention, that is, they are from nonanalogous art.

(19) Those skilled in the art would find it physically impossible to combine the references in the manner suggested.

(20) If combined, the references would produce an inoperative combination.

(21) It would be necessary to make modifications, not taught in the prior art, to combine the references.

(22) Even if combined, the references would not meet the claim.

(23) The combination suggested requires a series of separate, awkward combinative steps that are too involved to be considered obvious.

Applicant's claim 21 includes the recitation of a stuffed animal toy. The last OA alleges that Lang discloses a toy. Applicant respectfully traverses this.

Random House Webster's Unabridged Dictionary defines the term "toy" as a "plaything". The American Heritage Dictionary, Second College Edition, defines "toy" as "an object for children to play with". It is respectfully submitted that Lang does not fit definitions of a toy.

In contrast, Lang discloses an animated character which is useful for remotely monitoring an area for security purposes, also marketing products or sponsors before an audience, for example, at an amusement park, in a nightclub, or on a recorded or live television. See Lang, col 3, lines 60-65.

Furthermore, applicant's claim requires "said voice modulating means operably connected with said means for disguising said first audio input". The last OA alleges that Lang digital effects unit 540 is operably connected with a microphone 126 for "disguising" the first audio input. In contrast, Lang col. 9, lines 15-23 makes no reference to disguising the audio input, but merely states

that the possible effects are reverb, feedback, time delays and infinite repeats. Applicant respectfully submits that these effects would not disguise the first audio input.

In addition, applicant's claim specifies that "said second means includes a transmitter, a transmitter antenna, a receiver, a receiver antenna, and an amplifier, all of which are disposed on a single circuit board and/or in a protective case disposed in the interior of said stuffed animal toy." The last OA is silent as to this required recitation.

Applicant respectfully submits that the claim recitation immediately quoted above does not inject new matter. In particular, Fig. 1 shows components 16 and 23, and Fig. 2 shows the electrical components.

Furthermore, specification page 5, lines 1-2, states "The electrical components 4-8 of this toy/radio arrangement 2-9 may preferably, but not necessarily, be disposed on a single circuit board and/or in a protective case 23."

In addition, specification page 5, lines 14-20, states: "The electrical components of this operator/radio arrangement 13-21 may preferably, but not necessarily, be disposed on a single circuit board and/or in a protective case 16.... With the exception of the headset 13, the electrical components of this operator/radio arrangement may be disposed in the protective case 16 for hooking onto a belt or garment 24 of the operator 12."

The last OA alleges that Lang discloses the claimed invention except for the toy being stuffed; and that Brodrib discloses an ambulatory toy that is stuffed. Applicant respectfully submits that the combination of Lang and Brodrib as suggested by the last OA would not be obvious to the artisan, but more importantly would not result in the invention as claimed by applicant.

Lang relates to an “ANIMATED CHARACTER SYSTEM WITH REAL-TIME CONTROL”, classified in Class 40, Subclass 411.

On the other hand, Brodrib relates to an “AMBULATORY ANIMAL TOY”, classified in Class 446, Subclass 373.

In contrast, applicant’s invention relates to “AN INTERACTIVE STUFFED ANIMAL TOY SYSTEM”, which is not classified in any of the classes or subclasses of the applied art.

Applicant respectfully submits that the applied references, combined as suggested by the last O.A., are from very different technical fields than that of applicant’s invention, that is, they are from non-analogous art.

Lang and Brodrib do not contain any justification to support their combination, much less in the manner proposed.

With regard to the proposed combination of Lang and Brodrib, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior art § 103 rejection, *the references themselves* (or some other prior art) must suggest that they be combined. E.g., as was stated in In re Sernaker, 217 U.S.P.Q. 1,6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.”

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S. P.Q. 193, 199 (C.A.F.C. 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the

claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO].”

As was further stated in Uniroyal, Inc. v Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 2434 (C.A.F.C. 1988) “[w]here prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself...*Something in the prior art must suggest the desirability and thus the obviousness of making the combination.*” [Emphasis supplied].

In line with these decisions, the Board stated in Ex parte Levengood, 28 U.S.P.Q. 2d 1300 (P.T.O.B.A.&I. 1993):

“In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention...That which is within the capabilities of one skilled in the art is not synonymous with obviousness...That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in that art, that ‘would lead’ that individual ‘to combine the relevant teachings of the references.’

...Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done."

In the present case, there is no reason given in the last O.A. to support the proposed combination, other than the statements "It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a toy that is stuffed as taught by Brodrib, since Brodrib states at col.1, lines 5-6 and col. 4, lines 30-33 that such a modification would give it an improved shape and better simulate a live animal."

However, the fact that the applied references each teach features aimed at solving different problems is not sufficient to gratuitously and selectively substitute parts of one reference (Brodrib) for a part of another reference (Lang) in order to meet applicant's novel claimed combination.

The O.A. noted (page 3) that the combination of Lang and Brodrib produces an advantage (improved shape and better simulation of a live animal). Applicant submits that the fact that the combination produces advantages militates in favor of *applicant* because it proves that the combination produces new and unexpected results and hence is unobvious.

As stated in the above Levengood case,

"That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention".

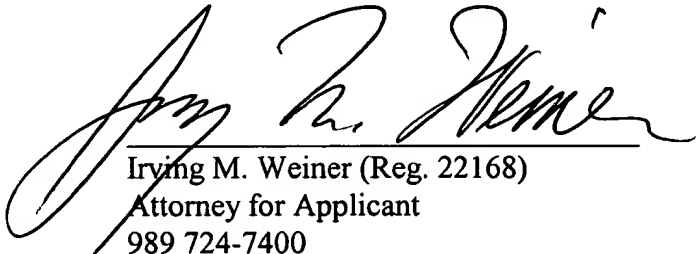
Applicant therefore submits that combining Lang and Brodrib is not legally justified and is therefore improper. Thus, applicant respectfully submits that the rejection on these references is also improper and should be withdrawn.

In view of the foregoing, applicant respectfully submits that the application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner does not believe that the application is in condition for allowance, then it is respectfully requested that the Examiner promptly telephone the undersigned attorney for applicant in an effort to facilitate the prosecution, and/or to narrow the issues for appeal, if necessary.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

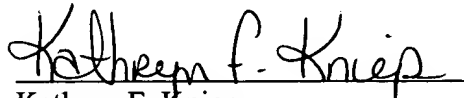


Irving M. Weiner (Reg. 22168)
Attorney for Applicant
989 724-7400

Date: July 7, 2004
Weiner & Burt, P.C.
635 N. US-23
POB 186
Harrisville, MI 48740

Certificate of Mailing

I hereby certify that the foregoing amendment was sent to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, as first class mail on July 7, 2004.



Kathryn F. Kniep